

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-64 and 66-77 are pending. Claims 1-64 and 66-77 stand rejected.

Claims 1, 33, and 34 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicants submit that the amendments do not add new matter.

Applicants reserve all rights with respect to the applicability of the Doctrine of Equivalents.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-29, 31-64, and 66-77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. US2005/267303 A of Johnson, et al. ("Johnson"), in view of U.S. Publication No. US2006/0126101 A1 of Shutt et al. ("Shutt").

Applicant has amended claim 1 to include identifying at least one action set forth in the image; and identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image and the identifying the at least one document is performed based on the first plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the image.

Applicant respectfully submit that neither Johnson nor Shutt discloses such limitations of amended claim 1.

The Examiner stated that "Johnson does not ...disclose identifying at least one document, wherein the identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes is performed

using a single image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document.

Johnson, in fact, discloses using one form to create another form with fields for requesting operations in relation to items. More specifically, Johnson discloses that when a fax server receives an image of the Starter form (**Figure 7**), the fax server creates a new form to request a particular operation (**Figure 8**).

Shutt, in contrast, discloses a system and method for detecting interruptions that occur during sending pages via fax. More specifically, Shutt discloses barcoded sheets associated with one or more pages transmitted through the fax system (paragraph [0067]). In particular, Shutt discloses

In addition to using barcodes sheets for identification of documents, the system enables the user to generate barcode sheets that instruct the system to take a predefined action associated with a folder and/or document in the repository. For example, a user can generate a barcode sheet that instructs the system to send an email notification indicating that a particular folder contains all documents necessary for the business transaction. This type of barcode sheet is referred to as an "action barcode sheet" and is typically included as the last page of a fax containing documents and coversheets. An example of such an action, shown in FIG. 6, is an e-mail notification that the folder is complete.
(Shutt, paragraph [0066])(emphasis added)

Thus, Shutt merely discloses barcode sheets for identifying the documents, and another barcode sheets that instruct the system to take a predetermined action. In contrast, amended claim 1 refers to identifying at least one action set forth in the image; and identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image and the identifying the at least one document is performed based on the first plurality of the indication areas in the same image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the same image.

Applicant respectfully submits that Johnson does not teach or suggest a combination with Shutt, and Shutt does not teach or suggest a combination with Johnson. It would be impermissible hindsight, based on applicant's own disclosure, to combine Johnson and Shutt. Moreover, even if the method of creating of form of Johnson were combined with the method for detecting interruptions of Shutt, such a combination would lack identifying at least one action set forth in the image; and identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image and the identifying the at least one document is performed based on the first plurality of the indication areas in the same image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the same image, as recited in amended claim 1.

Given that claims 2-29, 31-64, and 66-77 contain the limitations that are similar to those discussed with respect to amended claim 1, applicant respectfully submits that claims 2-29, 31-64, and 66-77 are not obvious under 35 U.S.C. § 103(a) over Johnson in view of Shutt.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Shutt, further in view of U.S. Patent No. 5,680,223 to Cooper ("Cooper").

Applicant respectfully submit that neither Johnson, Shutt, nor Cooper disclose identifying at least one action set forth in the image; and identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image and the identifying the at least one document is performed based on the first plurality of the indication areas in the same image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the same image, as recited in amended claim 1.

Johnson, in fact, discloses using one form to create another form with fields for requesting operations in relation to items (**Figures 7 and 8**).

Shutt, in contrast, discloses barcode sheets for identifying the documents, and another barcode sheets that instruct the system to take a predetermined action.

Cooper, in contrast, discloses assigning an image domain label to the file (Abstract).

Applicant respectfully none of the references teach or suggest a combination with each other. It would be impermissible hindsight, based on applicant's own disclosure, to combine Johnson, Shutt, and Cooper. Moreover, even if the method of creating of form of Johnson and the method for detecting interruptions of Shutt were combined with the method of labeling of the document of Cooper, such a combination would still lack identifying at least one action set forth in the image; and identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image and the identifying the at least one document is performed based on the first plurality of the indication areas in the same image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the same image, as recited in amended claim 1.

Given that claim 30 depends from amended claim 1, and add additional limitations, applicant respectfully submits that claim 30 is not obvious under under 35 U.S.C. § 103(a) over Johnson in view of Shutt, and further in view of Cooper.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 1/3/07

By: 

Michael J. Mallie
Reg. No. 36,591

1279 Oakmead Parkway
Sunnyvale, California 94085-4040
(408) 720-8300